

Application No.: 09/691352

Case No.: 55126US002

Remarks

Claims 1-19, 26-31, 35 and 47-42 are pending.

§ 103 Rejections

Claims 1-19, 26, 27, 30, 31 and 35 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent Number 5,783,303 to Tsuei ("Tsuei"). The Examiner states that Tsuei discloses an article with a plurality of ceramic granules bonded to a polymeric film by a radiation curable aliphatic urethane acrylic copolymer. However, the element of a ceramic coated granule is not taught in Tsuei.

As applicant previously argued, "in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents." MPEP 2144.06. The Examiner has offered no evidence that any such equivalency is recognized in the prior art. Applicants can find no such evidence in Tsuei. Thus, the Examiner has not met the required burden and the rejection should be withdrawn.

The Examiner responded by stating that the burden of *prima facie* obviousness is met by the combination of "two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose." M.P.E.P. 2144.06. However, the Examiner has not shown any evidence that the ceramic granules of Tsuei and the ceramic coated granules of the present application are indeed equivalent. MPEP 2144.06 assumes, at the very least, that the Examiner is relying on prior references that disclose each element of the claim rejected.

As stated in Applicant's prior response, the Examiner has not shown ceramic coated granules in the art, much less that they would be equivalent to the ceramic granules of Tsuei. Tsuei is directed to a purpose other than roofing shingles, and therefore Tsuei does not teach that an equivalent of the ceramic granules of Tsuei is useful as a roofing granule. Also, nothing in Tsuei would suggest making the modification suggested by the Examiner. In fact, the Examiner's argument that the granules in the present claims could be a ceramic granule coated with a ceramic material is irrelevant to the issue at hand. Even if so, Tsuei fails to teach or

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suggest ceramic coated granules and additionally fails to suggest that a ceramic coated granule is equivalent to a ceramic granule.

As Tsuei fails to teach or suggest "ceramic coated granules" as defined in the pending claims, a *prima facie* case of obviousness has not been established, and the rejection of claims 1-19, 26, 27, 30, 31 and 35 under 35 U.S.C. 103(a) should be withdrawn.

The rejection of claims 1-19, 26, 27, 30, 31 and 35 under 35 USC § 103(a) as being unpatentable over Tsuei has been overcome and should be withdrawn.

Claims 28, 29, and 37-39 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent Number 5,783,303 to Tsuei ("Tsuei"). Claims 28, 29 and 37-39 all depend, directly and indirectly, from Claim 1. For the reasons stated herein and in our last response, Tsuei fails to present a *prima facie* case of obviousness for Claim 1. Therefore, Tsuei fails to present a *prima facie* case of obviousness for Claims 28, 29 and 37-39.

The rejection of claims 28, 29, and 37-39 under 35 USC § 103(a) as being unpatentable over Tsuei has also been overcome and should be withdrawn.

§ 102 Rejections

Claims 1, 10, 12, 16, 26, 27, 28, 35 and 37-42 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent Number 5,484,477 to George et al. ("George"). The Examiner states that George discloses an integrated granule product made with ceramic-coated slate based granules, and the granules are adhered to the asphalt surface of a shingle by a thin film coating. Additionally, the Examiner states that the thin film includes an adhesion promoter. However, the Examiner has erred in stating that a film is taught in George, which is an element of the independent claims 1, 12, and 40.

George teaches to coat a thin film of organic oil onto the granule surface. Col. 7, ll. 3-5. This coating may include an adhesion promoter. Col. 7, ll. 17-25. There is no teaching or suggestion in George to create a separate film. In fact, George fails to teach or suggest curing or solidifying the oil coating on the granules at all, much less to solidify them as a separate film.

The rejection of claims 1, 10, 12, 16, 26, 27, 28, 35 and 37-42 under 35 USC § 102(b) as being anticipated by George has been overcome and should be withdrawn.

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In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Respectfully submitted,

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